

REMARKS

Claims 1-7, 9-12, and 14 are pending in this application. Claims 7, 9, and 12 independent. Claims 5 and 6 have been withdrawn from consideration. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected Applicants' claim for domestic priority. The Examiner further rejected claims 1-4, 7, 9-12, and 14 under 35 U.S.C. § 102(e) as being anticipated by Aria et al. (U.S. Patent No. 6,527,642); and rejected claims 1-4, 7, 9-12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Kamimura (JP 60-191,758) in view of Eda et al. (U.S. Patent No. 6,044,723). Applicants respectfully traverse these rejections.

Interview

Applicants wish to thank the Examiner for the Interview conducted on February 15, 2006. During the Interview, the parties discussed the differences between the prior art and the claimed invention. The parties agreed that the elements of claim 3 were not taught by Kamimura. It is respectfully submitted that the comments made herein are made further to the discussions had with the Examiner during the Interview.

Priority

The Examiner rejected Applicants' claim for domestic priority asserting the claim must be made within the later of four (4) months from the filing date of the application or 16 months from the actual filing date of the prior application citing to MPEP § 201.11 Section E. Applicants respectfully disagree that this is the applicable rule for the present application.

The present application was filed September 6, 2000. The Rules relied upon by the Examiner is effective for applications filed on or after November 29, 2000. Applicants

respectfully submit that Applicants' claim for priority is in accordance with 37 CFR § 1.78. As such, it is respectfully requested that the Examiner's rejection of Applicants' claim for priority be withdrawn.

Claim Rejections – 35 U.S.C. § 102

As applicants' claim for priority is proper, Applicants rely on the Petition to Correct Inventorship previously filed in the present application together with the Claim for Priority to Aria et al. (U.S. Patent No. 6,527,642). Based upon this claim for priority, Applicants respectfully submit that Aria et al. is not prior art with regard to the present application. It is respectfully requested that the outstanding rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

In support of the Examiner's rejection of the claims, the Examiner asserts that Kamimura teaches a worm gear arrangement having the claimed biasing device for biasing a worm into engagement with a worm gear. The Examiner provides no indication to the Applicants as to what embodiment of Kamimura the Examiner is relying upon. During the Interview, the parties agreed that at least Fig. 1 fails to teach the elements as recited in the claims. Should the Examiner maintain his rejection of the claims, Applicants respectfully request the Examiner provide Applicants with specific support in the Kamimura reference to indicate what elements he is relying upon to support his claim rejection so that Applicants may have a proper opportunity to respond by withdrawing the finality of the outstanding Official Action. Applicants will respond to the outstanding rejection to the extent that the Applicants can understand the Examiner's position.

Kamimura discloses, in Fig. 2, removal of backlash between the worm wheel 2 and the worm 8 and the rotation torque of the operation handle 9 being executed by changing a thickness and a number shims 10 and 11 interposed between the bearing cases 3 and 4 and an inner surface of the housing 1, and adjusting a screwing amount of adjusting screws 12 and 13 pressing the bearing cases 3 and 4 toward to the worm wheel.

In contrast, the present invention as set forth in claim 7 recites, *inter alia*, an electric power steering apparatus comprising a biasing member biasing, via a bearing, the worm shaft toward the worm wheel, a concave member accepting the bearing, and a housing for housing the bearing and the concave member, wherein the biasing member is movably acceptable only toward the concave member. Applicants respectfully submit that the teachings of Kamimura as depicted in Fig. 2 fails to teach or suggest these claim elements.

Additionally, with regard to Figs. 3 and 4 of Kamimura, Kamimura discloses the pressing force of the pressing means 60 being directly applied to the worm 23. A pair of brackets 51 and 52 are separated in the axial direction of the transmission shafts 25 and are integrally formed in a side close to the transmission shaft 25 of the slider 41, and a pair of pins 53 and 54 which are in parallel to an axis of the worm 23 are attached to the brackets 51 and 52.

However, there is no teaching or suggestion in Kamimura that is directed to a biasing member biasing, via a bearing, the worm shaft toward the worm wheel, a concave member accepting the bearing, and a housing for housing the bearing and the concave member, wherein the biasing member is movably acceptable only toward the concave member.

Eda et al. fails to cure the deficiencies of the teachings of Kamimura as Eda et al. fails to teach or suggest these claim elements. As such, Applicants respectfully submit that neither of these references, either alone or in combination, teach or suggest all of the claim elements. Applicants maintain that claim 7 is not obvious over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 1-4 and 14 are allowable for the reasons set forth above with regard to claim 7 at least based upon their dependency on claim 7. It is further respectfully submitted that claims 9 and 12 include elements similar to those discussed above with regard to claim 7 and thus these claims, together with claims dependent thereon, are not obvious for the reasons set forth above with regards to claim 7.

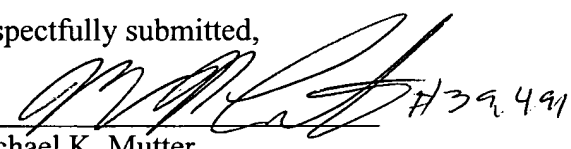
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: March 23, 2006

Respectfully submitted,

By  #39,491
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant